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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/509,408

03/27/2000

KLAUS MALER

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29177

7590

07/15/2004

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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT

PAPER NUMBER

2686

18

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,408

Applicant(s)

MALER, KLAUS

Examiner

Naghmeh Mehrpour

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. **Claims 7-12**, are rejected under 35 U.S.C. 102(e) as being anticipate by Jarrett et al. (US Patent Number 6,735,432 B1).

Regarding **Claim 7**, Jarrett teaches a communication terminal apparatus for wireless communication with a selected base station of one of at least two communication systems (col 6

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lines 20-29), the communication terminal apparatus being logged on as ready to receive the selected base station (col 11 lines 43-47), the communication terminal apparatus comprising:

recognition means for recognizing one of the at least two communication systems (col 13 lines 26-35, lines 65-66), the recognized communication system having the selected base station (col 13 lines 65-67, col 14 lines 1-5), and

control means **configured to allocate** a network address to the recognized communication system under which the communication terminal apparatus can currently be reached (col 14 lines 24-33) and **communicating** control information via the selected base station to a control network address **stored in a memory (col 15 lines 33-46) of the communication apparatus** (col 15 lines 33-53);

wherein the network address communicated to the control network address stored in memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached (col 15 lines 33-45).

Regarding **claim 8**, Jarrett teaches a communication terminal apparatus for wireless communication with a selected base station of one of at least two communication systems (col 13 lines 25-35), the communication terminal apparatus being logged on as ready to receive the selected base station (col 11 lines 43-47), the communication terminal apparatus comprising:

recognition means for recognizing one of the at least two communication systems, the recognized communication system having the selected base station (col 13 lines 26-35, lines 65-67, col 14 lines 1-5), and

control means **configured to allocate** a network address to the recognized communication system under which the communication terminal apparatus can currently be reached (col 14 lines 24-33) and **communicating** control information via the selected base station to a control network address **stored in a memory of the communication apparatus (col 15 lines 33-46)**, for influencing an activation/deactivation condition related to another communication system not having the selected base station (col 7 lines 25-47); and

the network address communicated to the control network address stored in memory is used for assisting in handling a call intended for the communication terminal apparatus but directed to a communication system via which the communication terminal apparatus cannot be reached (col 15 lines 33-53).

Regarding **Claims 9-10**, Jarrett teaches a communication terminal apparatus wherein the control information activates a call redirection relating to a subscriber address under which the communication terminal apparatus can be reached via another communication system not having the selected base station (col 13 lines 9-25), given corresponding readiness to receive the another communication system by the communication terminal apparatus (col 11 lines 43-47).

Regarding **Claim 11**, Jarrett teaches a communication terminal apparatus wherein the memory stores a control network address of a mobility server (col 14 lines 41-67).

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Regarding **Claim 12**, Jarrett teaches a communication terminal apparatus wherein the memory stores a plurality of control network addresses of a plurality of communication systems (col 14 lines 54-66), and the communication terminal apparatus further comprising:

selection means for selecting at least one control network address of another communication system not having the selected base station (col 15 lines 1-23).

Response to Arguments

3. Applicant's arguments with respect to claims 7-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. **Any responses to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for formal communications indented for entry)

Or:

(703) 308-6306, (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Va., sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Melody Mehrpour whose telephone number is (703) 308-7159. The examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m.

If attempt to reach the examiner are unsuccessful the examiner's supervisor, Marsha Banks-Harold be reached (703)305-4379.

NM

July 5, 2004


7/12/04
LESTER G. KINCAID
PRIMARY EXAMINER